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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,046	09/30/2003	Michael P. Whitman	11443/158	7736

26646 7590 06/23/2006

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EXAMINER

LEUBECKER, JOHN P

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/676,046		WHITMAN, MICHAEL P.	
	Examiner		Art Unit	
	John P. Leubecker		3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 29-32, 35-64, and 67-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk et al. (WO 93/15648) for the reasons set forth in numbered paragraph 4 of the previous Office Action, paper number 11282005, which refers back to numbered paragraph 8 of Office Action, paper number 05262005. All commentary will be repeated below for Applicant's convenience.

Wilk et al. disclose a shaft (14), an image capture device (CCD 90 or 152), a light source (26,34 or 160), a control module (12), and a power module (38) which can include a integrally housed power source (260, Fig.12). All components of Wilk et al. are "sterilizable" and "autoclavable" since everything is "sterilizable" and "autoclavable" (and the inherent size of the Wilk et al. device would allow for the device to fit inside any known machine for doing either). The shaft (14) is bendable using steering cables (72a,72b,74a,74b, Fig.2), and is thus flexible, and the steering cables are connected to motors (252,254, Fig.12). The light source and image capture device can be mounted at the distal end of the shaft (Figs.7 and 8) and the distal light source can include a second power source (158, Fig.8) at the distal end of the shaft. The control module includes a video processor (not numbered but inherent in the circuitry associated with the CCD for supplying the video monitor (32), page 7, last paragraph) and a integrally mounted display screen (32). The shaft includes channels (52a,52b,52c) which are capable of conveying fluid or providing suction (60c,60a). Any of these channels can permit the passable of tools

through the shaft. The shaft further includes a data transfer cable (88, Fig. 4) for transmitting data to the video processor. The control module includes a control unit (any one of the housing for manually manipulating the device, the joystick (104, Fig. 5), the buttons shown on the side of the display (Fig. 5), or any of the controls of the suction source, air source, water source or light source) and a controller (any one of the electrical or mechanical means that control the suction source, air source, water source and light source, the processing circuitry which delivers an image to the display, motors (252, 254), wireless transmitter (156, Fig. 8), etc.). Since almost anything can be hand-held, the device of Wilk et al. is configured to be. The device of Wilk et al. is intended to be placed within the body so, as best understood, it is configured as an endoscope, proctoscope and anoscope.

As for the newly added limitations regarding the shaft being sealed, Wilk et al. teaches that the channel that receives the optical guide member is "closed at the distal end" (page 5, fourth full paragraph) (note window 28 in Figure 3 for example) and that the "present endoscope is easier to clean and maintain in a sterile condition" (page 5, fifth full paragraph). This suggests to the reasonable person that window seals the shaft, otherwise the optical guide member (20) would not remain in a sterile condition. Since the newly added subject matter set forth the condition for being sterilized as being "sealed", at least the sealed shaft will meet this limitation. It is noted that the optical guide member (20) would also appear to be sealed at least at the distal end, and thus, as per the newly added subject matter, sterilizable. There is no reason to believe that any portion of the Wilk et al. device could not be sterilized or autoclaved, even though that might not be intended.

Clearly, regarding the citations in Wilk et al. from the paragraph immediately above, the sterility must also depend not only on the sealed window, but the shaft (tube 14) itself (a window sealed with the shaft would have no more effect than one that is not, if the shaft itself is not sealed). Keeping the optical guide member in a sterile condition (while the device is inside of a body) would inherently require the material making up the outside of the tube to be “fluid-tight”, if not “air-tight”. Since the “fluid-tight seal” refers to sheath (13) about the shaft (page 5, lines 6-8) as pointed out by Applicant in the remarks, the entire shaft, which would include the distal and proximal ends, would be fluid-tight. Since there is no reason to believe that tube (14) in Wilk et al. is made of multiple materials along its length so if it is fluid-tight at its distal end, it is fluid-tight at the proximal end. It is noted that Applicant’s sheath (13), which is providing this fluid-tight seal, is not disclosed as extending over the distal-most end plane of the shaft, nor the proximal-most end plane of the shaft.

3. Claims 1-8, 10-28, 33, 34, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk et al. in view of Kanno et al. (U.S. Pat. 4,884,133) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 11282005, which refers back to numbered paragraph 10 of Office Action, paper number 05262005. All commentary will be repeated below for Applicant’s convenience.

Wilk et al. disclose the elements as set forth above but including a light source but fails to specify the nature of the light source. Kanno et al. demonstrates that it is known to use an LED or an array of LEDs in an endoscope for providing illumination light (note 26G, 26R, 26B of Figure 1(c) for example). Since it is well known and well within the ordinary skill in the art to

recognize the advantages of LEDs (e.g., low power requirements, small size, etc.) over normal incandescent lamps and use of LEDs in an endoscope for the same purpose Wilk et al. (i.e., illumination) has been previously contemplated, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used LEDs for the generic “light source” of Wilk et al.

Response to Arguments

4. Applicant's arguments filed June 5, 2006 have been fully considered but they are not persuasive.

The Wilk et al. reference is discussed above with respect to the newly added subject matter. As pointed out above, the part of the specification cited by applicant alludes to the “fluid-tight seal” as being a property of the sheath on the shaft. From Applicant’s arguments (specifically, page 12, first full paragraph), it appears that Applicant might have intended to recite a sealing relationship at the coupling between the proximal end of the shaft (12b) and the control module (14) (which would make sense out of Applicant’s arguments being directed at the coupling between Wilk’s tube and control module). However, the Examiner did not find disclosure in Applicant’s specification related to whether or not such coupling is “sealed”. The drawings do not help either. In any event, as claimed and interpreted, the “fluid-tight seal” is a property of the sheath which, as pointed out in the previous Office Action, is suggested as being at least “fluid-tight”.

Regarding the intended use of the Wilk et al. device, the Examiner has pointed out how the prior art structure meet the claim structure. The intended use of the device of Wilk et al. and Applicant's alleged invention is not at issue here.

Again it is importantly noted that the Wilk et al. reference was only applied to the claims to maximize the number of claims that could be met by any particular reference. Although Wilk et al. is a relevant reference, there are many references cited in the previous Office Action that, alone or in combination, **meet the limitations of at least the independent claims**. Applicant is **strongly urged** to figure out what he has invented and make the claim language reflect what is believed to be patentable, **using the cited prior art of record as a guide**. This will greatly aid the Examiner in citing and applying references that are more specifically directed to what Applicant believes is the invention.

Conclusion

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

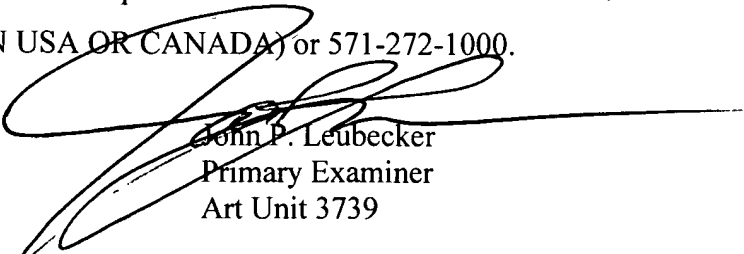
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl